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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,726	11/19/2001	Avi J. Ashkenazi	P2730P1C60	9979
35489	7590	01/18/2005	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 275 MIDDLEFIELD ROAD MENLO PARK, CO 94025-3506			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/989,726

Applicant(s)

GENENTECH, INC.

Examiner

Robert Landsman

Art Unit

1647

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: Claims 139-142.

Claim(s) withdrawn from consideration: \_\_\_\_\_.


8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

Robert Landsman  
Primary Examiner  
Art Unit: 1647

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claims 139-142 under 35 USC 112, second paragraph. Applicants have amended the claims to recite "SEQ ID NO:325" instead of "SEQ ID NO:326." Applicants' arguments have also overcome the rejection of claims 149-152 under 35 USC 112, first paragraph, regarding new matter.

Continuation of 5. does NOT place the application in condition for allowance because: remain rejected under 35 USC 112, first paragraph, for the reasons already of record on pages 3-4 (enablement) and page 5 (written description) of the Office Action dated 9/17/04. Applicants' arguments have been considered, but are not deemed persuasive. Applicants argue that they were in possession of the claimed invention and that the artisan would know how to use these polynucleotides as probes or primers. These arguments have been considered, but are not deemed persuasive. Applicants have not demonstrated that any polynucleotide other than that encoding SEQ ID NO:326 can be used as a tissue marker in order to identify cancerous tissue. Polynucleotides other than those encoding SEQ ID NO:326 would likely hybridize to polynucleotides other than those encoding SEQ ID NO:326 and would be expected to provide a distinct tissue expression pattern. It is noted that a lack of utility may also exist for regarding the use of these "hybridizing polynucleotides" for the specific and substantial purpose of tissue markers as defined by those encoding SEQ ID NO:326, since these polynucleotides may have different expression patterns. Applicants may wish to contact the Examiner to discuss this issue.

Continuation of 10. Other: The objection to claims 140-142 has been withdrawn in view of Applicants' amendments to the claims to recite "greater." .

  
**ROBERT LANDSMAN**  
**PATENT EXAMINER**